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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,098

01/21/2004

Yukio Yamaguchi

60188-747

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20277 7590 10/21/2008  
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EXAMINER

CHANG, LEONARD

ART UNIT

PAPER NUMBER

2812

MAIL DATE

DELIVERY MODE

10/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/761,098	<b>Applicant(s)</b> YAMAGUCHI, YUKIO	
	<b>Examiner</b> LEONARD CHANG	<b>Art Unit</b> 2812	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 16-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/244,074.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This Office Action is in response to Applicant's Remarks and Supplemental Declaration filed with the Office on July 24, 2008. It is noted that the format of the Amendment filed on October 9, 2007 now comply with 37 CFR 1.173(d). It was previously noted In the Office Action mailed on May 1, 2008 that all claims from application 11/504,091 and the present application 11/761,098 are in condition for allowance. However, due to the declaration in this application being defective as noted below, the allowability of these claims is rescinded at this time, as they are now currently rejected. Therefore, claims 1-8 and 16-25 are currently pending in this re-issue application.

### *Specification*

2. The examiner notes that the Specification amendment filed with the Office on July 24, 2008 has been received, however, is still defective.

3. Applicant needs to include cross reference to the other reissue applications in the first sentence of the specification of each of the reissue applications. MPEP § 1451(I).

Note the statement:

More than one reissue application has been filed for the reissue of **Patent No. 9,999,999**. The reissue applications are application numbers **09/999,994 (the present application), 09/999,995, and 09/999,998**, all of which are **divisional reissues of Patent No. 9,999,999**.

4. This new first sentence must be added to the specification in addition to the Specification amendment filed with the Office on July 24, 2008

***Declaration***

5. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

6. Specifically, a ***new Declaration*** need contain the additional following:

a. **Applicant's mailing address** must be presented in the Declaration. It is noted that an address was provided in the Supplemental Declaration filed with the Office on July 24, 2008; however, it is not made clear of record whether this is the **residential address (Applicant)** or the **mailing address (Matsushita Electronic Industrial Co., Ltd. Of Osaka Japan)**. See 37 CFR 1.63(c)(1).

Where the residential address and the mailing address are the same, it must be **clearly** made of record.

b. The Declaration is not specific enough under MPEP § 1414(II)(C). MPEP § 1414(II)(C) states that ***“(a)ny error in the claims must be identified by reference to the specific patent claim(s) and the specific patent claim language wherein lies the error.”*** It further states that ***“(a) statement of “failure to include a patent claim directed to ...”*** and then presenting a newly added claim would not be considered sufficient “error” statement since the Applicant has not pointed out what the other patent claims lacked that the newly added claim has, or vice-versa. The present Declaration merely states that the error was the patent claiming less than the patentee had a right to claim. This

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cited error is not specific enough under MPEP § 1414(II)(C). In other words --  
what was wrong with the patented claims, specifically?

### ***Claim Rejections***

7. **Claims 1-8 and 16-25** are rejected as being based upon a **defective reissue Declaration** under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

**Note:** This rejection based on a defective declaration was in the Office Action mailed on March 15, 2006 and October 9, 2007. However, the Declaration was not corrected in response to the rejection(s).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD CHANG whose telephone number is (571)270-3691. The examiner can normally be reached on Mon-Thurs 9:00 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Garber can be reached on (571) 272-2194. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leonard Chang/  
Examiner, Art Unit 2812

/Alexander G. Ghyka/  
Primary Examiner, Art Unit 2812